

## **REMARKS**

In the Final Office Action mailed on March 24, 2006, claims 1-2, 8, 12, 26 and 33-34 have been rejected as obvious under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,758,465 (“the ‘465 patent”) in view of U.S. Patent No. 4,543,763 (“the ‘763 patent”). Claims 14 and 15 have been rejected under 35 U.S.C. §103(a) as obvious over the ‘465 patent in view of the ‘763 patent, and in further view of U.S. Patent No. 6,205,730 (“the ‘730 patent”). Claims 31-32 and 35 have been rejected under 35 U.S.C. §103(a) as obvious over the ‘465 patent in view of the ‘763 patent, in further view of the ‘730 patent, and in further view of U.S. Patent No. 6,481,680 (“the ‘680 patent”).

The obviousness rejections of claims 14-15, 31-32 and 35 that rely on the ‘730 patent are traversed for the reasons set forth below.

### **A. MAY 12 PHONE CONFERENCE**

As an initial matter, the Applicant’s undersigned attorney is grateful for the courtesy the Examiner showed during a phone conference held on May 12 to discuss potential allowability of the claims. Rejections of claims 14-15, 31-32 and 35 were discussed during the phone conference as were particular aspects of the ‘730 patent. Although no agreement was reached during the phone conference, the Examiner further explained his understanding of the cited references, including the dimples 42 of the ‘730 patent. The phone conference was useful to frame issues related to the ‘730 patent for consideration herein and/or during a subsequent appeal (if necessary).

**B. THE '730 PATENT TEACHES AWAY FROM THE REQUIRED PENETRATING ENGAGEMENT OF CLAIMS 14-15, 31-32 AND 35.**

It is submitted that the cited '730 patent teaches away from the required elements of claims 14-15, 31-32 and 35, and therefore that this obviousness rejection must be withdrawn. Claims 14-15 and 31-32 depend from claim 1, which requires anti rotation elements configured for penetratingly engaging the substrate that the fastener is driven into and that frictionally holds the fastener. Independent claim 35 requires anti-rotation elements configured for engaging and penetrating the substrate that the fastener is driven into and that frictionally holds the fastener in place. The Final Office Action relies on the '730 patent to disclose or suggest these required elements.

The '730 patent teaches a roofing plate for holding a roofing membrane in place. Abstract. It is well known that puncturing a roofing membrane can lead to roof leaks and is therefore very undesirable. The '730 patent recognizes this when it specifically teaches that it is "...important that the dimples 42 ... lightly grip the roofing membrane 18 *without puncturing it...*" Col. 4, lines 58-60 (emphasis added). Although FIG. 3 of the '730 patent shows dimples 42 engaging a roofing membrane 18, it is submitted that this is not penetrating engagement as is required by claims 14-15, 31-32 and 35, and instead that (as best understood) FIG. 3 shows the dimples 42 deflecting (but not penetrating) a flexible roofing membrane 18 (which may be, for instance, an elastic roofing membrane). The above-cited portion of the '730 patent confirms this ("...lightly grip the roofing membrane 18 *without puncturing it...*"). Puncture of the roofing membrane 18 by the dimples 42 could lead to roof leaks and is therefore to be avoided.

For this reason, it is submitted that the obviousness rejection of claims 14-15, 31-32 and 35 over the '730 patent is improper and should be withdrawn.

**C. THE '730 PATENT FAILS TO TEACH ENGAGEMENT WITH THE SUBSTRATE AS REQUIRED BY CLAIMS 14-15, 31-32 AND 35**

FIG. 3 of the '730 patent is also useful to illustrate other differences between the invention of claims 14-15, 31-32 and 35 and the disclosure of the '730 patent. For example, claims 14-15, 31-32 and 35 all require, among other elements, that the anti-rotation elements are configured for engaging the substrate that the fastener is driven into and that frictionally holds the fastener in place. That is, the anti-rotation elements engage the same substrate that frictionally holds the fastener in place, with an example being the substrate 14 (e.g., a ceiling) as illustrated in FIG. 1 of the application.

The '730 patent, on the other hand, teaches that its dimples 42 lightly engage the roofing membrane that is *sandwiched between* the roofing plate 10 and a roof that holds the fastener in place. Col. 4, lines 58-65. Accordingly, the dimples 42 do not engage the substrate that frictionally holds the fastener in place (i.e., the roof), but instead lightly engage a roofing membrane which sits on top of the substrate (e.g., a roof). It is critical that the roofing membrane 18 remain free from puncture to avoid leaks. This is yet another reason that the obviousness rejection of claims 14-15, 31-32 and 35 over the '730 patent is improper and should be withdrawn.

**D. CLAIM 15 REQUIRES A TRUNCATED CONE SHAPE, WHILE THE '730 PATENT TEACHES ROUNDED DIMPLES**

Claim 15 requires a generally truncated cone shaped anti-rotation element. Although the Final Office Action admits that none of the references teach this required element, it suggests that it would have been obvious to modify the rounded dimples of the '730 patent to achieve the required truncated cone shape. It is submitted that this is improper, however, since the '730 patent teaches away from this required element when it teaches the importance of rounded tips: "It is important to note that the dimples 42 have *rounded tips* so that they may lightly grip the roofing membrane 18 without puncturing it..." Col. 4, lines 58-60 (emphasis added). It is therefore improper to cite the '730 patent in an obviousness rejection of claim 15, and this rejection should be withdrawn.

Further, the roofing plate of the '730 patent is applied from above to hold an underlying roofing membrane 18 in place. Through the application of the roofing plate from above pressure is brought downward onto the membrane 18 through gravitational and application forces. This increases the importance of rounded dimple 42 tips to avoid undesirable puncture of the underlying roofing membrane 18 which might result through use other shapes such as the truncated cone shape required by claim 15.

**E. THERE IS NO MOTIVATION TO COMBINE THE UNRELATED CITED PATENTS.**

There must be some suggestion or motivation disclosed in the references or in the commonly known art to combine the cited references to support an obviousness rejection. MPEP §2143.01. It is submitted that the obviousness rejection of claims 14-15 and 31-32 and 35 is improper because there is no motivation to combine the cited

references with one another. Citing these four unrelated references improperly views the prior art only with the benefit of hindsight gained after considering the claimed invention.

The '763 patent teaches a masonry anchor useful to thread a hole in masonry. The '465 patent teaches a device for securing a rod to a ceiling. As best understood, the disclosed device is for overhead use on interior ceilings. The '730 patent, on the other hand, discloses a roofing plate for holding roofing membrane on an exterior roof. No motivation can be found for combining these unrelated references, and the obviousness rejection of claims 14-15 that relies on these unrelated references is therefore improper and should be withdrawn.

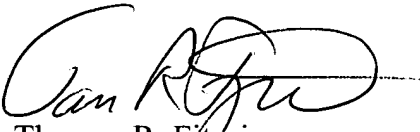
Even accepting for sake of argument only that some motivation might be found for combining all three of the unrelated '465, '730 and '763 patents, no motivation can be found for combining them with the significantly different fourth reference - the '680 patent. The '680 patent teaches a storage device for storing purses and the like on a dining table and is therefore completely unrelated to the arts of roofing plates for holding roofing membranes in place, rod hangers for attaching rods to an overhead ceiling, and masonry anchors for threading a hole in masonry. Further, claim 35 claims a rod hanger for securing a rod to a substrate such as a ceiling. The purse storage device of the '680 patent is so distant from this art that an artisan would not look to it for teaching. For these reasons it is submitted that the obviousness rejection of claims 31-32 and 35 that cites four unrelated references is improper and should be withdrawn.

**F. CONCLUSION**

It is submitted that claims 14-15, 31-32 and 35 in their current form are allowable over the cited prior art, and reconsideration of the obviousness rejection of these claims is requested. Upon issuance of an Advisory Action withdrawing the rejection of these claims, all other claims will be cancelled or amended to place them in allowable condition. All correspondence should continue to be directed to Applicant's primary attorney Ms. Lisa Soltis at the correspondence address of record.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By   
Thomas R. Fitzsimons  
Registration No. 40,607

May 24, 2006

Suite 2500  
300 South Wacker Drive  
Chicago, Illinois 60606  
(312) 360-0080  
Customer No. 24978